

Appl. No. 09/980,225
Amtd. Dated December 16, 2003
Reply to Office Action of October 23, 2003

• • R E M A R K S / A R G U M E N T S • •

The Official Action of October 23, 2003 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment the limitations of dependent claim 4 have been incorporated into independent claim 1 and dependent claim 4 has accordingly been canceled.

In addition, dependent claim 7 which recited the same limitations as dependent claim 4 has also been canceled.

Furthermore, non-elected claims 6 and 11-14 have been canceled without prejudice or disclaimer.

The amendments to the claims are believed to be properly enterable after Final Rejection because the changes to the claims only involve incorporating limitations of a dependent claim into an independent claim.

Moreover, the changes to the claims involve the cancellation of seven dependent claims which reduces the issues that remain under prosecution.

Finally, for the reasons set forth below it is submitted that the changes to the claims place the application into condition for allowance.

Entry of the changes to the claims is respectfully requested.

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On page 2 of the Official Action the Examiner has taken the position that claims 6 and 11-14 are directed to an invention that is independent or distinct from the invention originally claimed.

The Examiner instituted a Restriction Requirement and took the position that claims 1-5 and 7-10 were constructively elected by prosecution.

Claims 6 and 11-14 were accordingly withdrawn as being directed to a non-elected invention.

Claims 6 and 11-14 have been canceled herein without prejudice or disclaimer. Applicants reserve their right to prosecute the subject matter of claims 6 and 11-14 by filing and prosecuting one or more divisional applications during the pendency of the present application.

Claims 1, 3-5 and 8-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over European Patent Application No. 0 014 336 to Vaidya.

Claims 1-3, 5 and 9 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,484,844 to Oshima et al. or U.S. Patent No. 5,914,195 to Hori et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding rejections of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is respectfully requested.

The Examiner has relied upon Vaidya as showing "chlorinated polyethylene copolymers having the chlorination percent as requisite claim 1."

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The Examiner states that "[t]he instantly claimed coupling agent is exemplified at page 8" in Vaidya.

Applicants disagree and submit that Vaidya teaches a "coagent" that can be included in the compositions which coagents are "organic compounds containing at least one, preferably two or more, aliphatic unsaturated groups " that "are frequently attached to Si, O, N, or P atoms.

First, it is noted that applicants' claim a "coupling agent" selected from the group consisting of vinylic, epoxy or methacryloxy silane coupling agents.

There is an art-recognized distinction between "coagents" and "coupling agents" which relates to the functions of these components.

Vaidya teaches "coagents" not applicants' claimed "coupling agents."

Accordingly, Vaidya fails to anticipate or teach applicants' claimed invention.

It is moreover noted that Vaidya dose not distinguish between coagents which are organic compounds containing aliphatic unsaturated groups that are attached to "Si, O, N, or P atoms."

That is, Vaidya fails to teach a preference or advantage to include a silane-based material as apposed to O-, N-, or P-based components.

Applicants' disclosure includes evidence of prevention of blister formation which is attributed to the use of silane coupling agents.

Vaidya fails to teach the use of a silane coupling agent for any purpose, let alone any preference to the use of a silane-based material as apposed to O-, N-, or P-based components.

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Vaidya is directed to heat resistant, curable, chlorinated polymers that useful as wire and cable coverings "because of their resistance to ozone, oxidizing chemicals, heat and light."

Nothing in Vaidya suggests that applicants' claimed molding material which is suitable for use in conjunction with carbon dioxide refrigerants or that the molding material can be used to make sealing elements that will effectively seal carbon dioxide.

Accordingly, Vaidya neither teaches nor suggests applicants' claimed invention.

Oshima et al. is directed to vinyl chloride resin elastomer compositions which have excellent compression set as "demanded for materials of e.g. glass runs and weather strips."

Hori et al. is directed to thermoplastic resin compositions that are "excellent in creep resistance and bond strength" and which are useful as sealing materials and gaskets.

Neither Oshima et al. nor Hori et al. teach applicants' claimed silane coupling agents in combination with chlorinated polyethylene, let alone any a composition that would resist blistering when in contact with carbon dioxide.

The Examiner appears to be taking the position that the various prior art references teach compositions that would "inherently" be useful in conjunction with carbon dioxide refrigerants.

As held by the court of appeals in *In re Shetty*:

Inherency is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result.

The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is known. (*In re Shetty*, 195 USPQ 753(CCPA 1977))

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In the present case, the use of chlorinated polymer compositions does not lead to the conclusion that the prior art compositions are useful in conjunction with carbon dioxide refrigerants or that all chlorinated polymer compositions can be used to make sealing elements that will effectively seal carbon dioxide.

Inherency cannot be found in the present case where the prior art fails to recognize the use of applicants' claimed molding materials, especially when the claims recite the limitation of a "molding material for use with carbon dioxide refrigerant."

It is believed that the phrase "for use with carbon dioxide refrigerant" breathes life and meaning into the claims. Note the court of appeals holding in *Loctite Corp.*:

Term in preamble of patent claim breathes life and meaning into the claims and hence is a necessary limitation to them. *Loctite Corp. v. Ultraseal, Ltd.*, 228 USPQ 90, at 92 (CAFC 1985)

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

Moreover, the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

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It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

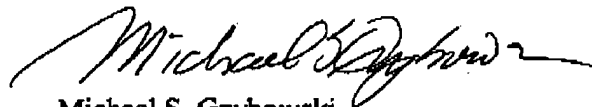
Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

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